Appl. No. 09/852,581
Amdt. dated September 8, 2003
Reply to O.A. of June 6, 2003

PATENT
Docket No. 27600/M239A

Remarks

Claims 1-13 are pending and at issue in the present application.

Applicants would like to thank the examiner for the courtesies extended during the interview conducted July 15, 2003, by Examiner Hong and Manisha C. Wulf (applicants' attorney). At that time, Examiner Hong agreed that the finality of the Office action dated June 6, 2003, was incorrect and that such finality would be withdrawn.

Applicants traverse the rejections of the claims at issue as unpatentable over de Heus et al. in view of Sumita et al.

Claim 1, and claims 2-13 dependent thereon, specify a method of assembling a book, wherein the method includes the steps of storing a first number of pages and specifying pagination information including an indication of whether a stored page is to be selectively included in the book. The method further includes the step of determining whether a stored page is to be assembled into the book based on the pagination information, wherein a total number of stored pages to be assembled into the book is less than the first number. Still further, the method includes the step of generating page description language instructions for production of the book in accordance with the pagination information.

As an initial matter, applicants contend that it is not appropriate to combine de Heus et al. and Sumita et al. to reject the claims herein because Sumita et al. is non-analagous art. A person of ordinary skill in the art would not have looked to the teachings of Sumita et al. to modify de Heus et al. because de Heus et al. relates to pagination and printing of directories and Sumita et al. relates to a method and apparatus for filtering information. The filtering apparatus disclosed in Sumita et al. is used to filter articles in order to determine the relevance of the articles to a user's preferences, and has nothing to do with pagination or printing of books or other materials. "A reference is analogous art if it is within the inventor's field of endeavor." *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992). One of ordinary skill in the art of assembling books would not have looked to the field of filtering information because the latter is so far removed from the former in terms of relevance. In other words, the teachings of Sumita et al. are not in the field of endeavor of the present invention.

In addition, contrary to the examiner's assertion, neither de Heus et al. nor Sumita et al. discloses or suggests a method of assembling a book including the step of specifying pagination information including an indication of whether a stored page is to be selectively included in a book. Nor does either reference disclose or suggest such a method including

Appl. No. 09/852,581
Amdt. dated September 8, 2003
Reply to O.A. of June 6, 2003

PATENT
Docket No. 27600/M239A

the step of determining whether a stored page is to be assembled into the book based on the pagination information wherein a total number of stored pages to be assembled in the book is less than a first number. Still further, neither reference discloses or suggests the step of generating page description language instructions for production of the book in accordance with the pagination information. All of these steps are specified by the claims at issue.

In fact, de Heus et al. discloses a pagination system and process for paginating types of printed book directories such as telephone books, membership directories, catalogues, etc. For each type of directory, the pagination system accepts a plurality of data entries and a set of layout and pagination parameters. The data entries and layout and pagination parameters are specified for each directory type. The system uses the layout parameters to define the general appearance or physical characteristics of a book page or sections of the book and the pagination parameters are used during pagination to control the position of the display entries and anchor listings and headings relative to the column and page boundaries. During pagination, an optimal page layout is created for each page of the book directory in order to minimize waste of available printing space. Page description language is generated for each page of the book directory for production thereof on a suitable output device such as a laser printer or typesetter. Significantly, all of the book directories of a particular directory type are identical to one another as printed.

As noted above, Sumita et al. discloses an information filtering system that receives text articles containing text and images supplied from a plurality of information sources and transmits selected text articles to subscribed user terminals according to user preferences. The text articles are transmitted to the user in any number of presentation formats via a communication network.

Because the art does not disclose or suggest that it would be desirable or even possible to provide a method of assembling a book including the steps of storing a first number of pages, specifying pagination information including an indication of whether a stored page is to be selectively included in a book, determining whether a stored page is to be assembled into the book based on the pagination information, wherein a total number of stored pages to be assembled in the book is less than the first number, and generating page description language instructions for production of the book in accordance with the pagination information, as specified by the claims at issue, it is evident that the claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the

Appl. No. 09/852,581
Amdt. dated September 8, 2003
Reply to O.A. of June 6, 2003
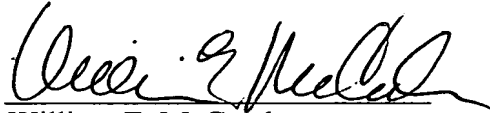
PATENT
Docket No. 27600/M239A

claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the obviousness rejection should be withdrawn.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims at issue and allowance thereof are respectfully requested.

Respectfully submitted,

Law Offices of
McCracken and Frank

By: _____

William E. McCracken
Registration No. 30,195

Date: September 8, 2003

200 W. Adams
Suite 2150
Chicago, IL 60606
Telephone: (312) 263-4700
Facsimile: (312) 263-3990
Customer No.: 29471